

**REMARKS**

Initially, Applicant notes that its Information Disclosure Statement (IDS) which was submitted with the filing of this application on December 21, 2001 has not been indicated as being considered. Applicant has submitted herewith a duplicate of its IDS and 1449 form listing the references identified for the Examiner's consideration along with the date-stamped post card evidencing the submission of this IDS. Applicant respectfully requests the Examiner to consider the references listed on the 1449 form and return the same to Applicant evidencing such due consideration.

Claims 8-12 are currently pending in the present application. Claims 1-7 have been cancelled without prejudice or disclaimer thereto. Claims 8-10 were amended to more distinctly and clearly define the invention. In particular, claim 8 was amended to delete the original wherein clause and to add the recitation that the entire working electrode is located closer to the sample solution supply port than the counter electrode. Support for this amendment should be apparent from the detailed specification and figures. For example, on page 10, beginning at line 6 and in conjunction with Figure 1, Applicant discloses that working electrode 7 is located at a position closer to a sample solution port 12a than the counter electrode 6. Third electrode 8 is identified as being located at a position still closer to the sample solution supply port 12a than the working electrode 7. Further, as shown in Figure 2, the entire working electrode 7 is located closer to the sample solution supply port 12a than counter electrode 6. The advantage of this structural arrangement is also described in the various examples. For example, because the sample solution is introduced at port 12a, it crosses electrode 8 and then working electrode 7 and then counter electrode 6 in that order. As noted on page 12, beginning at line 3, the sensor detects the sample solution between counter electrode 6 and third electrode 8 so that the entire

exposed area of working electrode 7 is filled with the sample solution prior to the taking of measurements with working electrode 7. By this structural arrangement, then, working electrode 7 is completely or substantially covered by the sample solution prior to initiating measurements.

Claims 9 and 10 were also amended. In particular, claim 9 was amended with the language noted on page 12, beginning at line 3 of the specification and claim 10 was amended to recite that the working electrode, counter electrode and third electrode are electrically connected to three independent leads as is apparent from the figures and the disclosure on page 12, last paragraph. Accordingly, it is respectfully submitted that the amendments to the claims are fully supported by the specification and no new matter issues are raised thereby.

#### **Objections and Rejections to Claim 1-7**

Claims 1-7 have been cancelled without prejudice or disclaimer thereto. Accordingly, any objection or rejections of these claims have now been rendered moot.

#### **Double Patenting Rejection of Claims 8-12**

Claims 8-12 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,340,428 B1. Applicant has enclosed herewith a Terminal Disclaimer to obviate the double patenting rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully solicited.

#### **Rejection Under 35 USC 112**

Claims 9 and 10 were rejected under 35 USC 112 for allegedly failing to comply with the written description requirement or indefiniteness, respectively. Applicant traverses the rejection and respectfully submits that these claims are in compliance with 35 USC 112.

As noted above, on page 10, beginning at line 6, the specification discloses substantially the identical language found in claim 9. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claim 10 has been amended to further structurally limit the device of claim 8. In particular, claim 10 has been amended to recite that the various electrodes are electrically connected to independent leads. Accordingly, reconsideration and withdrawal of this rejection are respectfully solicited.

#### **Rejection Under 35 USC 102**

Claims 8-12 were rejected under 35 USC 102(b) as being anticipated by Yoshioka (U.S. 5,264,103). The rejection is traversed and it is respectfully submitted that claims 8-12 are patentable within the meaning of 35 USC 102(b).

Independent claim 8 is directed to a biosensor. The biosensor includes a working electrode, counter electrode and a third electrode wherein the entire working electrode is located closer to a sample supply support than the counter electrode. Claims 9-10 further define the features of the biosensor of claim 8.

Yoshioka is related to a biosensor and method for measuring a concentration of a substrate in a sample. Yoshioka, however, does not teach a biosensor wherein the entire working electrode is located closer to a sample supply port than the counter electrode. In contrast, Yoshioka, as shown in Figures 1-2, teaches an electrode system 19 with counter electrode 7 and working electrode 6, which is located in the middle of counter electrode 7. Thus, the working electrode 6 of Yoshioka is not entirely located upstream of the counter electrode. Even if there is no distinction between a counter electrode and a working electrode, Yoshioka does not show the structural relationship of one entire electrode upstream of another as described in claim 8.

Accordingly, at least for this reason, claims 8-12 are not anticipated by Yoshioka. Reconsideration and withdrawal of the rejection are respectfully solicited.

**Objection to the Abstract**

On paragraph 18 of the Office Action, the Abstract of the Disclosure appears objected to pursuant to MPEP 608.01(b). Applicant respectfully traverses this objection. Applicant notes that the Abstract was amended by Preliminary Amendment dated December 21, 2001, wherein the Abstract was reduced to less than 150 words. Accordingly, reconsideration of the objection and consideration of the amended Abstract made by Preliminary Amendment are respectfully solicited.

Based on the foregoing, Applicant respectfully submits that all issues concerning the patentability of the application have been addressed and that the application is in condition for allowance. Favorable consideration and allowance of the application are respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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